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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/173,445    10/16/98    KWITEK    B    KWI-001

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HOWARD N FLAXMAN  
AQUILINO & WELSH  
2341 JEFFERSON DAVIS HWY STE 112  
ARLINGTON VA 22202

EXAMINER

BLAU, S

ART UNIT

PAPER NUMBER

3711

DATE MAILED:

09/20/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/173,445

Applicant(s)

Kwitek

Examiner

Stephen Blau

Group Art Unit

3711

☒ Responsive to communication(s) filed on Jul 7, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1, 3, 7-10, 14, and 21-29 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1, 3, 7-10, 14, and 21-29 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 9

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 7 is indefinite for depending on a canceled claim.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 7-10 and 14 are rejected and claims 21 -29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minami in view of Huang (5,730,669) and Moore.

Minami discloses a tubular shell (5), a viscoelastic hand surface about the outer surface of the tubular shell having a thickness, a central section (Ref. no. 6, Col. 3 Lns. 2-4, Col. 3 Lns. 14-16, Fig. 3), a tubular shell being a soft elastomer in form of being made of rubber and being softer

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than the hand surface (Col. 3 Lns. 51-53), a golf club grip (Fig. 1), and a shell being substantially cylindrical shaped with a slight taper (Figs. 2-3). Minami does not disclose a specific thickness for a viscoelastic hand surface but clearly one skilled in the art of forming a grip with enough vibration absorption material would have selected a suitable thickness for a viscoelastic hand surface in which a thickness between 1/16 and 1/4 inch is included.

Minami lacks a viscoelastic hand surface being a viscous silicone gel contained within an elastomeric bag and a tubular shell having circumferential lips to contain the viscoelastic hand surface, a central section having a depth as defined by the first and second lips which is substantially the same as the thickness of a viscoelastic hand surface, and a viscoelastic hand surface having a thickness between approximately 1/16 inch and 1/4 inch. Huang discloses a shell having circumferential lips and a central section having a depth as defined by the first and second lips which is substantially the same as the thickness of a viscoelastic hand surface (Figs. 11 and 13). In view of the patent of Huang it would have been obvious to modify the grip of Minami to have lips on a tubular shell as defined by the claims in order to better secure a hand surface about a tubular shell and to make the grip visually pleasing to a user by having the outer diameter the same size between the tubular shell and the viscoelastic hand surface.

Moore discloses a viscoelastic hand surface being a viscous silicone gel (Col. 5 Lns. 32-67) material contained within an elastomeric bag for a tennis racket in order to produce a more comfortable to wear grip and to distribute the weight and pressure more evenly to a hand of a player (Col. 1, Lns. 19-27) and sheets of gel material of about 1/8 to 1/4 inch (Col. 10, Lns. 55-

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64). In view of the patent of Moore it would have been obvious to modify the grip of Minami to have a viscoelastic hand surface as defined by the claims in order to produce a more comfortable to wear grip and to distribute the weight and pressure more evenly to a hand of a player. In addition, it would have been obvious to modify the grip of Moore to have a viscoelastic hand surface having a thickness between 1/8 and 1/4 inch in order to provide enough material to absorb vibrations without adding excessive weight.

*Response to Arguments*

4. The argument that it is improper to combine the references of Moore and Huang with Minami since Huang makes no suggestion as to the depth and of the guide cylinder and Huang makes no provisions for utilizing lips for retaining viscoelastic material between is disagreed with. Huang clearly shows the teaching of retaining an outer layer for a grip in figures 12 and 13. This teaching can be utilized for any type of outer layer. Moore provides a suitable outer layer. The argument that it is improper to combine the references of Moore and Minami since there is no suggestion to do so is disagreed with. Minami provides a general teaching of using a two layer grip with the outer layer being of high viscosity. Minami is quite to the specific types of high viscosity materials. Clearly this is a suggestion that suitable high viscosity materials can be substituted. Moore provides a suitable high viscosity material. The argument that nothing in the prior art suggests a range of thickness as defined by the claims is disagreed with. Moore clearly

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discloses a thickness for sheets of this material in the ranges as claimed. Golfers have all sorts of needs from minimizing weight of a grip in order to lower a swing weight of a club to maximizing grip material to minimizing damage to a players hand when impacting a ball. These ranges are a suitable range that can be selected by a golfer.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

### *Conclusion*

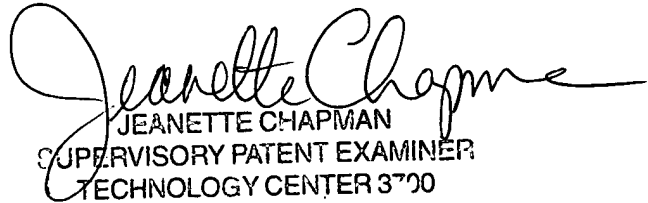
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (703) 308-2712. The examiner is

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available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Jeanette Chapman whose telephone number is (703) 308-1310. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858.



slb/19 September 2000



JEANETTE CHAPMAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700